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| 10/823,042 | 04/13/2004 | Vlad Pigin | 683492-0009 | 4104 |
| 20594 7590 08/20/2008 AKIN GUMP STRAUSS HAUER & FELD, LLP P O BOX 688 DALLAS, TX 75313-0688 | | | | |
| EXAMINER | | | | |
| DINH, MINH | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,042

Applicant(s)

PIGIN, VLAD

Examiner

MINH DINH

Art Unit

2132

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed 04/29/08. Claims 1, 4, 8, 11, 15 and 17 have been amended; claims 7, 14 and 20 have been canceled.

Response to Arguments

2. Applicant's arguments filed 04/29/08 have been fully considered but they are not persuasive. Applicant argues that Kanungo (US 2005/0120212) does not disclose a set of recipient rights include the ability to wipe out a document from any storage device as recited in independent claims 1, 8, and 15 (page 8, 4th paragraph). Kanungo discloses that the sender of an email message selects a set of recipient rights (i.e., control options) such as view, save protected and reply without original message (fig. 4, element 404) or view, save protected, print and reply without original message (fig. 4, element 406). The save protected right allows the recipient to save the message (paragraphs 0032-0033), and thus gives the recipient the ability to wipe out the message from any storage device (i.e. the recipient can save the message in a storage device(s) and once the message is saved, the recipient can delete the saved message from any storage device(s) in which the message is stored if he/she chooses to do so).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6, 8-13 and 15-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim 1 recited the limitation "wherein the recipient rights include an ability to wipe out the document from any storage device" (lines 4-5). Wherein the originally filed description discloses that recipient rights include right to "wipe the original document" (Specification, page 9, paragraph 0055), it does not disclose "the recipient rights include an ability to wipe out the document from any storage device". Therefore, the limitation is considered new matter. For examination purpose, the limitation is interpreted as "wherein the recipient rights include an ability to wipe out the document from any storage device in which the message is saved by the recipient". Claims 8 and 15 are rejected on the same basis as claim 1. Claims that are not specifically addressed are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 8-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanungo et al. (US 2005/0120212 A1) in view of Knauff (US 2001/0029581 A1). Kanungo discloses a system and method for a sender to control a document sent to a recipient in manner that (1) encrypts the document, and (2) restricts operations the recipient may perform on the received document (Abstract).

Regarding claims 1-2, 8-9 and 15, Kanungo specifically discloses a method comprising:

- selecting a document (i.e., an e-mail) to encrypt and send to the recipient (Fig. 1, step 102; Fig. 10, element 1000);

- selecting a set of recipient rights for the document wherein the recipient rights include the ability to wipe out a document from any storage device (i.e., the save protected right allows the recipient to save the message in a storage device(s) and once the message is saved, the recipient can delete the saved message from any storage device(s) in which the message is stored if he/she chooses to do so) (Fig. 4, elements 404, 406; paragraphs 0021-0033);

- encrypting the document (Fig. 1, step 110);

- sending the encrypted document and the set of recipient rights from the sender to the recipient (Fig. 1, step 114; paragraph 0013);

- receiving the encrypted document and the set of recipient rights at a terminal of the recipient (Fig. 1, step 114); and

- accessing the document according to the set of recipient rights (Fig. 4).

Kanungo discloses encrypting the electronic document. Kanungo does not disclose encrypting the set of recipient rights. Knauft discloses encrypting both an electronic document (i.e., data object) and a set of recipient rights (i.e., control data) (Figures 4B, 6B; paragraphs 0069, 0097). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kanungo's method and system to encrypt the set of recipient rights, as taught by Knauft, to prevent unauthorized access.

Regarding claims 3, 10 and 16, Kanungo discloses utilizing data specific to the recipient (i.e., the recipient's public key) in encrypting the document so that only the recipient can decrypt the document (Fig. 1, step 110; Fig. 9, steps 912, 914 and 920). Kanungo does not disclose utilizing data specific to the recipient's terminal, such as a computer passport of the recipient's terminal, in encrypting the document. Knauft discloses a method for encrypting a document, which utilizes both the recipient's public key and a computer passport of the recipient's terminal (i.e., a certificate certifying a key being the MAC address of the terminal of the recipient) (Fig. 3A, elements 118-121; Fig. 4B, elements 418 and 420; Fig. 5A; paragraphs 0051-0052, 0054, 0072-0075). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system of Kanungo to utilize a computer passport of the recipient's terminal, in addition to the recipient's public key, in encrypting the document, as taught by Knauft. The motivation for doing so would have been to control not only who but also which terminal can access the document (paragraph 0011).

Regarding claim 4, 11 and 17, Knauff further discloses using a machine key to encrypt a session key that is used to encrypt the document and set of recipient rights wherein the machine key is a symmetric key generated from the terminal's MAC address (fig. 4; paragraph 0054)

Regarding claims 5, 12 and 18, Kanungo further discloses using a certificate of the sender (Fig. 1, step 112).

Regarding claims 6, 13 and 19, Kanungo discloses using a certificate of the sender in the encryption process (Fig. 1, step 112). Kanungo fails to disclose that the certificate is selected from a set of certificates of the sender, i.e. the sender has more than one certificate. Official Notice is taken that both concept and advantage of an entity owning/having multiple certificates are well known and expected in the art. It would have been obvious to modify the method and system of Kanungo such that the sender has a multiple certificates, each of which could be used in a certain domain or for a certain purpose.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH DINH whose telephone number is (571)272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. D./

Examiner, Art Unit 2132

08/12/08

/Gilberto Barron Jr/

Supervisory Patent Examiner, Art Unit 2132